

10/3/01

**THIS DISPOSITION
IS NOT CITABLE AS PRECEDENT
OF THE T.T.A.B.**

Paper No. 15

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

John Rocco Roberto

v.

John Daniel Lees

Opposition No. 114,399
to application Serial No. 75/440,968
filed on February 26, 1998

Charles H. Knull of Graham & Campaign for John Rocco Roberto.

Alan B. Samlan of Knechtel, Demeur & Samlan for John Daniel Lees.

Before Seeherman, Holtzman and Rogers,
Administrative Trademark Judges.

Opinion by Rogers, Administrative Trademark Judge:

Opposer failed to file a brief and failed to respond to an order to show cause why this opposition should not be dismissed under Trademark Rule 2.128, 37 C.F.R.

§2.128. The Board then entered judgment dismissing the opposition. However, the proceeding also includes a

counterclaim by applicant for cancellation of opposer's pleaded Registration No. 2,132,356. Opposer and applicant both filed notices of reliance during assigned testimony periods, and applicant filed a brief in support of his counterclaim. Applicant now seeks "a favorable decision on its counterclaim."

Opposer's registration is for the mark G-CON in a stylized form of lettering for "entertainment services, namely, arranging and conducting conventions and/or exhibitions in the field of Japanese science fiction and fantasy." The registration issued January 27, 1998 based on an application filed January 13, 1997, and lists January 1, 1995 as the date of opposer's first use and first use of the mark in commerce.

Applicant's counterclaim for cancellation is based on two grounds. First, applicant asserts that opposer is not the owner of the G-CON mark. Specifically, he asserts that his business, Daikaiju Enterprises of Manitoba, Canada, "was the first entity to use the servicemark 'G-CON' in association with organizing, promoting, and conducting conventions and exhibitions in the field of science fiction movies, books and characters"; that Daikaiju Enterprises [hereinafter Daikaiju] "has become identified as the source of the

services" for which the G-CON mark has been used; that opposer, after having been employed by applicant, began doing business in Brooklyn, New York, as Daikaiju Enterprises and Productions [hereinafter DEP]; that opposer filed for and obtained the involved registration; that applicant's Daikaiju "did not assign its trademark rights, title, and/or interest in the 'G-CON' service mark"; and that opposer is not the owner of the G-CON mark which he registered and, therefore, the registration should be canceled.

Second, applicant asserts that opposer obtained the registration through fraud on the U.S. Patent and Trademark Office. Specifically, applicant relies on the allegations proffered in support of its claim that opposer is not the owner of the G-CON mark and asserts that opposer acknowledged, in a January 22, 1997 letter to applicant, that applicant and Daikaiju were "free to use the mark 'G-CON'" in conjunction with applicant's services; that the parties, "[i]n May of 1997" contractually agreed to a joint use arrangement; that opposer falsely represented in the declaration of the application which resulted in issuance of opposer's registration that "no other person, firm, corporation or association" had the right to use the G-CON mark; that

opposer knew of applicant's right to use the mark and therefore knew his declaration was false; that opposer intended the Office to rely on the false declaration; and that the Office did rely on the false declaration in issuing the involved registration.

Opposer, in his response to the counterclaim, admits that both parties, through their respective businesses, are engaged in the business of organizing and conducting conventions and exhibitions in the field of science fiction movies, books and characters in the United States; that opposer began doing business as DEP in November 1996; that "the letter of January 22, 1997 exists"; and that "the agreement of May of 1997 exists." Opposer otherwise denied the allegations of the counterclaim, denied that the letter and agreement have "force or effect," and asserted certain affirmative defenses to the counterclaim. Opposer did not, however, file a brief as defendant in the counterclaim and, therefore, did not pursue the affirmative defenses. Thus, we have not considered the defenses.

Turning to the record, we note that there are deficiencies with the evidence proffered by the parties. For example, each party has introduced printouts from Internet web pages without the testimony of the

individual who searched for and retrieved the pages. See, in this regard, Raccioppi v. Apogee Inc., 47 USPQ2d 1368 (TTAB 1998). Also, applicant has offered testimony in declaration form without a stipulation of the parties allowing this or a motion for leave to do so. See TBMP §§ 713.01, 713.02 and 716. Without any supporting testimony, applicant introduced with its notice of reliance copies of the letter and letter agreement that were already proffered in conjunction with the pleading of the counterclaim. Finally, although the printed publications introduced by each party may be made of record by notice of reliance¹, the articles and information in such publications are hearsay and applicant has not identified any exception to the hearsay rule that may be applicable. Thus, the publications have limited probative value in that they do not serve to prove the truth of the statements made therein. See *Midwest Plastic*, 12 USPQ2d at 1270 n.5; see also, Flowers Industries Inc. v. Interstate Brands Corp., 5 USPQ2d

¹ These are excerpts from Daikaiju's G-FAN magazine or, in one instance, an entire copy of one issue of the magazine. Both parties have introduced excerpts from this magazine. See, in regard to their proffer, Midwest Plastic Fabricators Inc. v. Underwriters Laboratories Inc., 12 USPQ2d 1267, 1270 n.5 (TTAB 1989) (When both parties introduced annual reports by notice of reliance and neither objected, the Board considered the material to be of record "in the same manner as if it had been stipulated into evidence.")

1580, 1582 n.4 (TTAB 1987), and Logicon, Inc. v. Logisticon, Inc., 205 USPQ 767, 768 n.6 (TTAB 1980).

We have not considered the Internet pages, or applicant's declaration, for the reasons stated above. We have considered the printed publications, but only to the extent outlined above. The letter from opposer to applicant and the parties' letter agreement regarding their respective uses of the G-CON mark have been considered as part of the record, since opposer admitted their existence in his answer to the counterclaim. Again, however, they have been given little weight, since they are not the subjects of any testimony and opposer has denied their "force or effect". Finally, we have considered the copies of Canadian documents regarding the legal status of Daikaiju as official records. See Trademark Rule 2.122(e).

Based on the pleadings and the materials in the record, we make the following findings of fact:

Applicant's business Daikaiju Enterprises was formed as a sole proprietorship in February 1994 and is the publisher of a magazine titled G-FAN;

Opposer worked as Associate Editor of G-FAN from at least January 1995 through November or December 1995;

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Opposer and applicant both were involved in the planning or promotion of G-CON conventions in the United States in 1995 and 1996, though the type and extent of their respective activities and responsibilities is unclear;

Opposer and applicant parted ways no later than some time after the 1996 convention and likely had differences of opinion resulting from the conduct of that convention;

Opposer filed his application to register the G-CON mark on January 13, 1997;

Opposer, in his letter to applicant on January 22, 1997, wrote that applicant "may plan any events you wish, and can even use the name G-CON for all I care...";

In May 1997, the parties agreed that neither party would take any adverse action regarding the other's convention and that "either party is free to use the G-CON mark with respect to their own convention," such letter agreement being signed by opposer on June 11, 1997 and by applicant on July 17, 1997;

Daikaiju, previously a sole proprietorship of applicant, was incorporated in April 1998.

Turning to the two claims made by applicant, we cannot find, on this record, that opposer was not the

owner of the G-CON mark when he applied for registration. The record is unclear on the precise nature of the relationship between opposer and applicant, and the division of responsibilities between them in regard to the planning, promotion and running of conventions. The documents regarding the legal status of Daikaiju are probative only to the extent that they show that any use of G-CON by Daikaiju, the sole proprietorship, would have inured to applicant's benefit. See In re Hand, 231 USPQ 487 (TTAB 1986) (Use of mark by corporation wholly-owned by individual presumed to inure to individual's benefit). However, there is no evidence of use of the G-CON mark for convention services by Daikaiju; as noted above, the statements contained in the copies of excerpts from Daikaiju's magazine regarding conventions are hearsay, and do not prove applicant's or Daikaiju's use of the mark for convention services.

The letter and letter agreement also are of little aid in determining whether opposer was owner of the G-CON mark when he applied for its registration.² Neither

² Opposer wrote, among other lines, the following to applicant in his January 22, 1997 letter:

The first use of the Trademark symbol next to the name G-CON was used on the tickets, produced by myself, months before G-CON... I have enough witnesses to back me up that G-CON was my baby more than yours.

evidences use of the mark by applicant or Daikaiju prior to the filing date of the application that resulted in opposer's registration. In short, applicant has failed to prove that he, not opposer, was the owner of the G-CON mark for convention services when opposer filed his application for registration.

We also find in favor of opposer in regard to applicant's claim of fraud. In our review of this claim, we have been mindful that fraud is a claim that requires strict proof. See, e.g., Global Maschinen GmbH v. Global Banking Systems, Inc., 227 USPQ 862, 867 (TTAB 1985), and authorities cited therein. Applicant has failed to meet the standard.

The only basis for the claim of fraud by opposer is that opposer knew of another party, i.e., applicant, with a right to use the G-CON mark, so that opposer's statement in his application declaration that opposer knew of no other with the right to use the mark was

Of course, the mere fact that opposer caused "the Trademark symbol" to be placed on tickets for a G-CON convention did not necessarily invest opposer with rights to that mark. Likewise, opposer's belief that the conventions were his "baby," does not necessarily make it so. Nonetheless, it was applicant who introduced the letter including these statements into the record, yet failed to provide any real evidence to support his claim that he, not opposer, acquired rights in the mark based on use of the mark in conjunction with the running of conventions in 1995 and 1996.

knowingly false. Because the pleading of the counterclaim focuses on the significance of opposer's letter and the parties' subsequent letter agreement, it is unclear whether applicant is asserting that the declaration was fraudulent when the application was filed or only that opposer committed fraud in failing to amend the declaration after the letter agreement was signed.³ Either way, such a claim requires proof that, *inter alia*, the declarant knew of another's superior right. See Ohio State University v. Ohio University, 51 USPQ2d 1289, 1293 (TTAB 1999). Based on the evidence of record, we cannot find that applicant has proved that opposer knew that applicant had superior rights in the mark when opposer filed and prosecuted his application.

Even if we assume, *arguendo*, that the relevant declaration statement was false at the time opposer filed its application, it may not have been understood by opposer to be false and would not, therefore, support a claim of fraud. See Alcan Aluminum Corporation v. Alcar Metals Inc., 200 USPQ 742, 746 (TTAB 1978), *quoting*

³ See In re Sun Refining and Marketing Co., 23 USPQ2d 1072, 1073 (TTAB 1991) (an applicant has a duty to "review and amend the declaration filed with its application" in certain circumstances). See also, Space Base Inc. v. Stadis Corp., 17 USPQ2d 1216, 1219 (TTAB 1990) ("[A] person can commit fraud upon

Rogers Corporation v. Fields Plastics & Chemicals, Inc., 176 USPQ 280 (TTAB 1972) ("there is a material legal distinction between a 'false' representation and a 'fraudulent' one, the latter involving ... an intent to deceive, whereas the former may be occasioned merely by a misunderstanding, an inadvertence, a mere negligent omission, or the like."); see also, Adolphe Lafont, S.A. v. S.A.C.S.E. Societa Anzioni Confezioni Sportive Ellera, S.p.A., 228 USPQ 589, 593 (TTAB 1985). For example, opposer apparently believed, as evidenced by his letter to applicant, that applicant was not entitled to register the G-CON mark in the United States. Nor does the letter agreement prove applicant's claim of fraud. Opposer's agreement to allow applicant to use the mark is not, per se, a recognition by opposer that applicant had superior rights in the mark.

Decision: The counterclaim petition for cancellation of opposer's registration is denied for failure of applicant to prove either that opposer was not the owner of the mark at the time of application or that opposer procured its registration through fraud on the Office.

the Office by willfully failing to correct his or her own misrepresentation, even if originally innocent...").